REMARKS

Reconsideration of the subject patent application is respectfully requested.

At this time, claims 26-35 are pending and all ten (10) claims stand rejected. More specifically, claims 26, 27, 29, 31, 32, and 34 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Justinien et al. in view of Fangman. Claims 28, 30, 33, and 35 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Justinien et al. in view of Fangman, and further in view of Tools Engineers Handbook.

Claims 26 and 31 represent the only two independent claims now pending and the following remarks focus on the recited claim elements in these two claims. However, the principal focus of the following remarks is on the manner in which the two cited patent references fail to disclose, in combination, each and every claim element now set forth in claims 26 and 31 and accordingly as set forth in all dependent claims.

The Examiner describes the Justinien et al. patent as disclosing "a connecting rod (14)" and "a piston pin (8)". Considering these two elements in reverse order, the Justinien et al. patent describes item (8) as being one of a plurality of "longer peripheral rods" (column 3, line 13). What is described as an elastic pin includes the plurality of longer peripheral rods 8 and "a concentric system of central rods 9" (column 3, line 15). Rods 8 are held in circular arrangement around balls 10. Rods 8 are "centrally fitted inside the bore of rings 11" (column 3, lines 21-22).

From this description of a multi-component, complex assembly, referred as to an "elastic pin", it is impossible to tell what component, if any, might deflect under load. It

is just as difficult, if not impossible, to tell what surface or surfaces might be adjacent to a deflecting "pin" portion such that this surface could be contoured if there is a desire to account for and accommodate any "pin" deflection. What happens if rods 9 deflect? Should we profile the rods 8?

It seems that there is no logical or rational basis to refer to this "elastic pin" as the typical pin (single component) used as part an engine cylinder and connecting rod assembly. Based on the FIG. 2 embodiment of Justinien et al., there are ten rods 8, a plurality of rods 9, and two balls 10. In the FIG. 4 embodiment, the number of components is even larger. As noted, there is no way to tell what might deflect or how. It is therefore suggested that the Examiner explain the nature of any pin deflection and identify any portion of the connecting rod that is shaped to provide a load bearing surface for this "pin" deflection.

In column 3, lines 35-43, the Justinien et al. patent talks about the radius of curvature 14^1 corresponding to the maximum radius of curvature of rods 8 when they bend. The objective is not stated to be for load bearing purposes, but instead, "so as to allow permanent engagement between said rods and said spring" (emphasis added). Since there is no "spring" in the referenced FIG. 2-FIG. 3 embodiment, it is not clear what, if anything, is being described. Any reliance on the Justinien et al. patent for some "teaching" of load bearing profiling of the connecting rod is obviously misplaced.

Returning now to the Examiner's contention that item 14 is a "connecting rod", the Examiner is asked to carefully consider the text of column 3, lines 35-43, in the Justinien et al. patent. As will be noted, the text of the Justinien et al. patent very clearly describes item 14^2 as the connecting rod, not item 14 as referenced by the Examiner in

the Office Action. Instead, item 14 is very clearly identified as a "central ring". As is clear from the text description in the Justinien et al. patent and as is very clear from the drawing illustrations, this central ring 14 is not a "connecting rod" as recited in claims 26-35. The recited bore of the connecting rod receives the piston pin. The connecting rod 14^2 of Justinien et al. receives the central ring 14, not a piston pin.

To the extent that the Examiner wants to address this substantial difference and deficiency of Justinien et al. by relying on the Fangman patent, it is pointed out that there is no suggestion in either citation to this type of significant modification to the essence of the invention of the Justinien et al. patent. In effect, what the Examiner would do is to substantially redesign the Justinien et al. structure so as to completely remove the central ring or perhaps make the central ring a unitary part of the connecting rod. Clearly, the Justinien et al. patent does not make any suggestion in this regard and it is far beyond what anyone would consider obvious to do based on the corresponding teachings of both Justinien et al. and Fangman. This is also far beyond what is permitted in terms of combining references. If central ring 14 is made unitary with connecting rod 14^2, do we widen the connecting rod in view of the fact that central ring 14 is noticeably wider? If we do not widen the connecting rod to match the width of central ring 14, how do we change the curvature? Do we also remove rings 11?

Over the years the Court of Customs and Patent Appeals (CCPA) and more recently the Court of Appeals for the Federal Circuit (CAFC) have addressed the issue of what criteria is to be applied when combining two or more references under 35 U.S.C. §103. While the facts may differ from case to case and while the CAFC panel may

change, the legal precedent established by the Board of Patent Appeals and Interferences and the CCPA has been followed and strengthened by the later cases of the CAFC.

Clearly and succinctly stated, before obviousness may be established, the examiner must show that there is either a suggestion in the art to produce the claimed invention or a compelling motivation based on sound scientific principles. Ex parte Kranz, 19 USPQ2d 1216, 1218 (Bd. Pat. App. & Inter., 1990). The case law makes it clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is vigorous application of the requirement for a showing of the teaching or motivation to combine prior art references. C.R. Bard, Inc. v. M3 Sys., Inc., 157 F.3d 1340 (Fed. Cir. 1998). Obviousness cannot be established by combining the teachings of prior art in order to produce the claimed invention, absent some teaching, suggestion, or incentive supporting the combination. In re Geiger, 2 USPQ2d 1276 (Fed. Cir. 1987). It is improper to reject the claimed invention for obviousness when nothing in the cited references, either alone or in combination, suggests or teaches the claimed invention. Evidence of teaching or suggestion is "essential" to avoid hindsight. In re Fine, 5 USPQ2d 1596 (Fed. Cir. 1988). Stated slightly differently, the mere fact that the prior art may be modified to reflect features of the claimed invention does not make modification, and hence the claimed invention, obvious unless the desirability of such modification is suggested by the prior art. In re Fritch, 23 USPQ2d 1780 (Fed. Cir. 1992).

It is generally accepted, however, that it is improper to change the basic principle under which the primary reference was intended to operate. In re Ratti, 123 USPQ 349 (CCPA 1959). It is not enough to pick out isolated features in earlier prior art patents,

combine them in one particular way with the application of hindsight acquired only from the applicant's own disclosure, and then say that it would have been obvious to select those particular features and to combine them in the particular way in which the applicant has. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. There must be some teaching or suggestion in the references to support their use in the particular claimed invention. Smithkline Diagnostics, Inc. v. Helena Laboratories Corp., 8 USPQ2d 1468 (Fed. Cir. 1988).

There must be some logical reason apparent from positive concrete evidence in the record that justifies a combination of primary and secondary references. In re Regel, Buchel and Plempel, 188 USPQ 136 (CCPA 1975). It is insufficient to show merely that each separate element of a claimed combination can be found in one or various prior art references. The mere fact that it is possible to find two isolated disclosures which might be combined in such a way to produce a new invention does not necessarily render such new invention obvious unless the prior art also contains something to suggest the desirability of the combination. In re Gergen, 11 USPQ2d 1652, (Fed. Cir. 1989).

It is impermissible within the framework of Section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art. In re Wessslau, 147 USPQ 391, (CCPA, 1965), Bausch & Lomb v. Barnes-Hind/Hydrocurve, 230 USPQ 416 (CAFC, 1986). Without the benefit of applicant's disclosure, a person of ordinary skill in the art would not know what portions of the reference to consider and what portions to disregard as irrelevant, or misleading.

In re Mercier, 185 USPQ 774 (CCPA, 1975). Combining prior art references without evidence of such a suggestion, teaching or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability – the essence of hindsight. Interconnect Planning Corp. v. Feil, 774 F2d 1132 (Fed. Cir. 1985).

In view of the foregoing remarks and legal analysis, the Examiner is respectfully requested to indicate that claims 26-35 are allowable and to pass those claims to issue.

Respectfully submitted,

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